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On 6/28/05  
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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

EBESU et al.

Serial No. 10/718,693

Art Unit: 1641

Filed: November 24, 2003

Examiner: G. Counts

For: CIGUA-DART METHOD FOR DETECTION OF CIGUATERA TOXINS

## RESPONSE

To the Commissioner of Patents and Trademarks

Sir:

In response to the Office Action mailed April 28, 2005,  
kindly consider the following:

Applicant provisionally elects Group I drawn to a method of detecting toxins, with traverse. Claims 21-26 read on the elected species.

Reconsideration and withdrawal of the election requirement are requested.

The claims of Groups I and II do not relate to materially different processes. The method defined by Group II relates to detecting toxins, per se, also described in the claims of Group I.

They are not related to materially different processes that would result in use for different purposes nor can they be used

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to practice a different process than that intended and claimed. Such a method cannot have the different applications contemplated by the examiner.

The inventions as described in the claims are neither independent nor distinct. In fact, the inventions as claimed arise from the same inventive effort. Where inventions are neither independent nor distinct, restrictions should not be required. Where inventions arise from the same inventive effort, restriction should not be required.

MPEP § 802.01 points out that a sub-combination and a combination are not independent inventions, and that a process and an apparatus used in the practice of the process are not independent inventions. That same section points out that "independent" means that there is no disclosed relationship between the subjects disclosed.

The examiner has not made any requirement based on the subject matter being independent. Therefore it is understood that the examiner concedes that the subject matter is not independent.

The examiner's requirement for restriction is based upon a holding that the subjects are distinct. That is, as pointed out in MPEP § 802.01, the examiner has held that the subject matter as claimed:

[is] capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE (novel and unobvious) OVER EACH OTHER.

The examiner has held under MPEP § 803 that the claimed

inventions:

are able to support separate patents and they are ...  
distinct (MPEP § 806.05-806.05(i)).

However, MPEP § 803 unequivocally states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

So that § 803 makes its point clearly, the serious burden requirement is repeated under the title:

CRITERIA FOR RESTRICTION BETWEEN  
PATENTABLY DISTINCT INVENTIONS

MPEP § 803 goes on to state that there are two criteria for a restriction requirement: one, that the inventions must be distinct as claimed; and two, that there must be a serious burden on the examiner if restriction were not required.

Section 803 goes on to state under GUIDELINES that an examiner must provide reasons and/or examples to support conclusions. The examiner has never stated that there would be a serious burden on the examiner if restriction were not required. Indeed, there should be no serious burden on the examiner.

The Federal Circuit has held that the patent office is obligated to make necessary findings and to provide an administrative record showing the evidence on which the findings are based, accompanied by the agency's reasoning in reaching its conclusion. In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). The decision "must be justified within the four corners of the record." In re Gartside, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000). The Examiner has neither made the necessary findings nor provided

any reasoning for the arbitrary species election requirement between the claims on record.

The inventions of Groups I and II are not different combinations in that they do not have "different modes of operation" as required by 806.04. Moreover, where inventions are related as disclosed but are not distinct as claimed, restriction is never proper (MPEP § 806). The inventions are not distinct as claimed because each invention defines "a method of detecting toxin" as claimed and as pointed out by the Examiner. Moreover, there is no serious burden on the examiner because both inventions should be classified together in the same single class. MPEP § 806 provides that if the inventions are not distinct as claimed, restriction is never proper.

For the above reasons, the Applicant believes that the claims should be examined together. Hence, the Examiner should kindly withdraw the restriction and consider claims 21-35 together.

Reconsideration and allowance of the application are requested. Reconsideration and withdrawal of the restriction requirement are requested.

Respectfully,



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